

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-20 are now in the application. Claim 1 has been amended. Claim 20 has been added. Claim 13 has been withdrawn.

In item 4 on page 2 of the above-identified Office action, claims 1-12 and 14-19 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner has stated that claim 1 is rejected as being incomplete for omitting the relationship between a test adapter and the contact pins.

The language of claim 1 has been amended to clearly recite the relationship between a test adapter and the contact pins.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic and/or clarificatory reasons. The changes

are neither provided for overcoming the prior art nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In item 6 on pages 3-5 of the above-mentioned Office action, claims 1-4, 6, 8, 10, and 17-18 have been rejected as being anticipated by Nishikawa et al. (US Pat. No. 6,356,093 B2) under 35 U.S.C. § 102(e).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, inter alia:

An apparatus for automated testing, calibration and characterization of test adapters for semiconductor devices, comprising:

a holder for holding a test adapter;

at least one probe head adjustably disposed relative to said holder, said probe head having at least two contact pins for testing said test adapter, said contact pins having an adjustable spacing distance therebetween; and

an adjustment device configured to adjust said probe head relative to said holder.

Nishikawa et al. show a test head 141 with two contacts 142A and 142B. The contacts 142A and 142B extend toward a table 5 and are driven by contact drivers 145A and 145B in order to be positioned relative to a circuit board 2 on the table 5, so that the contacts 142A and 142B can be brought into contact with predetermined points on the circuit board 2 (see column 11, lines 38-47).

The invention of the instant application differs from Nishikawa et al. in that according to the invention of the instant application no circuit board is tested at this level. Rather, the invention of the instant application serves for automatic testing, calibration, etc. of test adapters, which will later be used to test circuits. The completely different object of the invention of the instant application is clearly expressed in claim 1. Namely, the apparatus according to the invention of the instant application serves for automated testing, calibration and characterization of test adapters for semiconductor devices.

Clearly, Nishikawa et al. do not show "An apparatus for automated testing, calibration and characterization of test adapters for semiconductor devices, . . . ," as recited in claim 1 of the instant application. Nishikawa et al. also do not

show "a holder for holding a test adapter" and "contact pins for testing said test adapter" as recited in claim 1 of the instant application.

Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In item 8 on pages 5-6 of the above-mentioned Office action, claims 5, 7, and 9 have been rejected as being unpatentable over Nishikawa et al. and further in view of Deckert et al. (US Pat. No. 6,137,303) under 35 U.S.C. § 103(a).

As discussed above, claim 1 is believed to be patentable over the art. Since claims 5, 7, and 9 are ultimately dependent on claim 1, they are believed to be patentable as well.

In item 9 on pages 6-7 of the above-mentioned Office action, claim 11 has been rejected as being unpatentable over Nishikawa et al. and further in view of Vinson et al. (International Patent Application PCT/GB98/03262) under 35 U.S.C. § 103(a).

As discussed above, claim 1 is believed to be patentable over the art. Since claim 11 is dependent on claim 1, it is believed to be patentable as well.

In item 10 on page 7 of the above-mentioned Office action, claims 12 and 14-16 have been rejected as being unpatentable over Nishikawa et al. and further in view of Vinh (US Pat. No. 5,952,843) under 35 U.S.C. § 103(a).

As discussed above, claim 1 is believed to be patentable over the art. Since claims 12 and 14-16 are ultimately dependent on claim 1, they are believed to be patentable as well.

In item 11 on pages 7-8 of the above-mentioned Office action, claim 19 has been rejected as being unpatentable over Nishikawa et al. and further in view of Barker (U.K. Patent Application GB 2 240 435 A) under 35 U.S.C. § 103(a).

As discussed above, claim 1 is believed to be patentable over the art. Since claim 19 is dependent on claim 1, it is believed to be patentable as well.

Claim 20 has been added, which corresponds to the embodiment as shown in Figs. 7 and 8 of the drawings of the instant application. None of the cited references, whether alone or

in combination, shows an apparatus for automated testing, calibration and characterization of test adapters for semiconductor devices in which test signals can be supplied from both sides of the test adapter. More specifically, the contact needles 5 on the inside are contacted over the test head 9 while the contact surfaces 2 on the outside are brought in contact with the contact pins 16. The needles 5 are provided on a surface opposite the contact surfaces 2 of the test adapter 1, which has been inserted "reversed" in the holder 4 in this embodiment. This kind of two-sided testing of a test adapter is not disclosed in or obviated by the prior art.

In view of the foregoing, reconsideration and allowance of claims 1-12 and 14-20 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

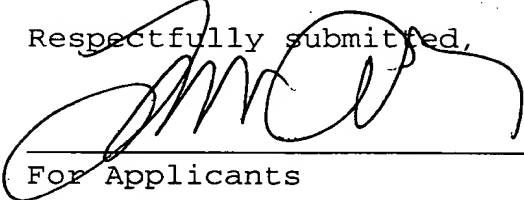
If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to 37 CFR Sections 1.16 and 1.17 to

Applic. No.: 09/931,686
Amdt. Dated April 23, 2004
Reply to Office action of January 27, 2004

the Deposit Account of Lerner and Greenberg, P.A., No. 12-
1099.

Respectfully submitted,

LAURENCE A. GREENBERG
REG. NO. 29,308



For Applicants

YC

April 23, 2004

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101